UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/697,004 | 10/31/2003 | Hirohisa Tashiro | SHO-0024 | 8250 |

23353 7590 02/07/2007
RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

| EXAMINER | |
|---|---|
| HSU, RYAN | |
| **ART UNIT** | **PAPER NUMBER** |
| 3714 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 02/07/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/697,004 | TASHIRO ET AL. | |
| | Examiner | Art Unit | |
| | Ryan Hsu | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 4-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

In response to the amendments filed on 11/08/06, claims 1, 4-5 have been amended and claims 2-3 have been canceled without prejudice. Claims 6-7 have been newly added and claims 1 and 4-7 are pending in the current application.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/697249.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and co-pending application 10/697249 are directed towards "a gaming machine comprising a game result display means for displaying a game result thereon; and beneficial state generating means for

generating a beneficial state for a player when a predetermined game result is displayed on the game result display means; wherein the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine".

Furthermore, claim 1 of the current application is directed towards the "second display means having a symbol display area through which the symbols displayed on the first display means are transmittably displayed and window frame display areas are formed around the symbol display areas in the second display means". With regard to claim 1 of co-pending application 10/697249 the second display means requires a second display means having "light transmitting symbols capable of displaying display contents of the first display device therethrough and the light transmitting symbols are variably display on the second display device". These two requirements are directed towards the same invention where a "symbol display area" allowing light to transmittably display through the window frame display areas and the "light transmitting symbols" both describe the same ability of allowing the second display symbol to allow light symbols to be represented on the second display. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1, 3-4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. (US 6,517,433) and further in view of Baerlocher et al (US 6,319,124 B1).**

Regarding claims 1 and 7, Loose et al. teaches a gaming machine comprising a game result display device for display a game result thereon and a beneficial state generating device for generating a beneficial state for a player when a predetermined game result is displayed on the game result display device (*see 'winning state' col. 3: ln 40-col. 4: ln 18*). Loose's game machine incorporates a game result display that includes a first display device and a second display device arranged in front of a display area of the first display device when seen from a front side of the game machine (*see Figs 1-2(a-b) and the respective related descriptions thereof*). Additionally, Loose teaches the first display device to include a plurality of symbol display parts capable of variably displaying one or more symbols and conducting stop display (*see Fig. 2(a-b) and the related description thereof*). Furthermore, Loose teaches for the second display to have display areas corresponding to the symbol display parts through which the symbols displayed on the first display device are transmittably displayed and window frame display areas are formed around the symbol display areas in the second display device (*see Fig. 1-2 and the related descriptions thereof*), and wherein the display mode of the window frame display area is changed so that the display device is adapted so that if the display is necessary to be displayed through the light transmittance rate of the second display may be made low to allow the first display device symbols to show through (*see*

*col. 5: ln 30-42*). However, Loose is silent with regards to the display devices to include an adapted illumination device for the reel symbols. In an analogous gaming patent, Griswold teaches the implementation of a display device that incorporates a reel display that allows for the different sections to be illuminated and thereby allowing the user to have a more visually stimulating experience (*see Fig. 1 and the related description thereof*). One would be motivated to incorporate this feature in that of a game machine in order to allow for the symbols to be varied and more clearly distinguished. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the symbol illumination techniques of Griswold with that of Loose to allow for a symbols display device to allow for the illumination of different symbol display parts.

Regarding claim 4, Loose et al. disclose a gaming machine wherein the display mode of the window frame display area is changed substantially at the same time that the stop display of the symbol is conducted (*see Figs 10(a-c) and the related description thereof*).

Regarding claim 5, Loose et al. disclose a gaming machine comprising an internal winning combination determination means for determining an internal winning combination (*see col. 5: ln 50-col. 6: ln 16*). Additionally, Loose et al. disclose a gaming machine wherein the display mode of the window frame display area is changed when the internal winning combination determination means determines a predetermined combination as the internal winning combination (*see Figs. 8(a-c), 10(a-c) and the related description thereof*).

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. and Baerlocher et al. as applied to claims above, and further in view of Jaffe (US 6,517,432).**

Regarding claims 6, Loose et al. teaches a gaming machine comprising a game result display device for display a game result thereon and a beneficial state generating device for generating a beneficial state for a player when a predetermined game result is displayed on the game result display device (*see 'winning state' col. 3: ln 40-col. 4: ln 18*). Loose's game machine incorporates a game result display that includes a first display device and a second display device arranged in front of a display area of the first display device when seen from a front side of the game machine (*see Figs 1-2(a-b) and the respective related descriptions thereof*). Additionally, Loose teaches the first display device to include a plurality of symbol display parts capable of variably displaying one or more symbols and conducting stop display (*see Fig. 2(a-b) and the related description thereof*). Furthermore, Loose teaches for the second display to have display areas corresponding to the symbol display parts through which the symbols displayed on the first display device are transmittably displayed and window frame display areas are formed around the symbol display areas in the second display device (*see Fig. 1-2 and the related descriptions thereof*), and wherein the display mode of the window frame display area is changed so that the display device is adapted so that if the display is necessary to be displayed through the light transmittance rate of the second display may be made low to allow the first display device symbols to show through (*see col. 5: ln 30-42*). However, Loose is silent with regards to the display devices to include an adapted illumination device for the reel symbols. In an analogous gaming patent, Griswold

teaches the implementation of a display device that incorporates a reel display that allows for the different sections to be illuminated and thereby allowing the user to have a more visually stimulating experience (*see Fig. 1 and the related description thereof*). One would be motivated to incorporate this feature in that of a game machine in order to allow for the symbols to be varied and more clearly distinguished. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the symbol illumination techniques of Griswold with that of Loose to allow for a symbols display device to allow for the illumination of different symbol display parts.

However, Loose and Baerlocher are both silent with regard to a feature that allows for the display area to incorporate moving objects that start to move along the window frame display area. In an analogous gaming patent, Jaffe teaches a feature wherein a character object moves and runs around the reel display area of the game machine (*see Fig. 1 and the related description thereof*). Jaffe teaches that one would be motivated to incorporate such a feature into their game machine in order to allow for a more visually stimulating experience for the user. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of Jaffe with that of Loose and Baerlocher to create a variable display device with objects moving along the frame display area.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Griswold (US 6,027,115)** – Slot Machine Reels having Luminescent Elements.

**Jaffe (US 6,551,187)** – Game Machine with Moving System on Game Array.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (571)272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RH

SCOTT JONES
PRIMARY EXAMINER

January 27, 2007